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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,379	12/03/2003	Frederic Guerin	PO8040/PS-1136	5580
34947 7590 10/02/2008 LANXESS CORPORATION 111 RIDC PARK WEST DRIVE PITTSBURGH, PA 15275-1112				
EXAMINER				
FIGUEROA, JOHN J				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
10/02/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/726,379

**Applicant(s)**

GUERIN ET AL.

**Examiner**

John J. Figueroa

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. Receipt is acknowledged of a request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission (amendment), filed on June 30, 2008. This request has been deemed proper and this application has been hereby examined in view of said amendment.

### ***Response to Amendment***

2. The 35 U.S.C. 103(a) rejection of amended claims 6-14 as unpatentable over USPN 6,268,417 B1 to Ozawa et al. (hereinafter 'Ozawa') in view of USPN 5,683,819 to Mori et al. (hereinafter 'Mori') previously made of record in item 1 on page 2 of the Final Office Action of December 13, 2007 (hereinafter 'FOA') has been withdrawn in view of Applicant's amendment to sole independent claim 6 in the response to FOA filed with RCE on June 30, 2008 ('Response') requiring the hydrogenated nitrile polymer to contain at least three monomeric components and further limiting its Mooney viscosity to less than 10.

3. The obviousness-type double patenting rejections of claims 6 and 9 as unpatentable over claims 6 and 7 of copending Application No. 10/878,080 ('080 app) has been maintained for reasons previously made of record in item 4 on page 2 of FOA.

4. The 35 U.S.C. 103(a) rejection of amended claims 6, 7 and 10-13 as unpatentable over Mori previously made of record in item 6 on page 3 of FOA has been withdrawn in view of Applicant's amendment to claim 6 as discussed above in paragraph #2.
5. The 35 U.S.C. 102(b) rejections as anticipated by United States Patent Number (USPN) 2,714,562 to Hechtman, hereinafter 'Hechtman'; by USPN 3,600,268 to Hori, hereinafter 'Hori'; and by USPN 2,656,292 to Hoover, hereinafter 'Hoover', that were previously made of record in items 10-12 on pages 4-6 of FOA, have been withdrawn in view of Applicant's amendment to claim 6 as discussed above in paragraph #2
6. The 35 U.S.C. 103(a) rejection of claims 6-14 as unpatentable over United States Patent Application Publication Number 2003/0171500 A1 to Guo (hereinafter 'Guo') in view of USPN 6,780,939 to Guerin (hereinafter 'Guerin'939'); USPN 7,105,606 (hereinafter 'Ong'); or by United States Patent Application Publication Number 2004/0113320 A1 to Guerin (hereinafter 'Guerin'320') have been maintained for reasons previously made of record in item 14 on page 6 of FOA.

### ***Response to Arguments***

#### ***The Double Patenting Rejection (item 3 on page 2 of FOA)***

7. Applicant did not file arguments in Response traversing the captioned rejection. Accordingly, this obviousness-type double patenting rejection has been maintained.

*The 35 U.S.C. 102 Rejections over Hechtman, Hori and Hoover (items 10-12 on pages 4-6 of FOA)*

8. Applicant's arguments filed in Response regarding the captioned 35 U.S.C. 102(b) rejections as anticipated by Hechtman, by Hori and by Hoover have been considered but deemed moot due to the withdrawal of these rejections in view of Applicant's amendment to independent claim 6 requiring the hydrogenated nitrile polymer to contain at least the three monomeric components recited in said claim while further limiting its Mooney viscosity to be less than 10. Hechtman and Hoover do not disclose the nitrile copolymer to contain the third monomer component that is an unsaturated carboxylic acid or derivative, whereas Hori does not teach the polymer having a Mooney viscosity of less than 10.

*The 35 U.S.C. 103 Rejections over Ozawa and Mori (items 1 and 6 of FOA)*

9. Applicant's arguments filed regarding captioned the 35 U.S.C. 103(a) rejections as unpatentable over Mori (item 6) and over Mori and Ozawa (item 1) have been considered but have become moot due to the withdrawal of this rejection in view of Applicant's amendment to independent claim 6 limiting the Mooney viscosity to be less than 10. Neither reference teaches or suggests a nitrile copolymer having a Mooney viscosity of less than 10.

*The 35 U.S.C. 103 Rejection over Guo with Guerin'939, Ong or Guerin'320 (item 14 of FOA)*

10. Applicant's arguments filed regarding the 35 U.S.C. 103(a) rejection of claims 6-14 as unpatentable over Guo in view of Guerin'939, Ong **or** Guerin'320 have been fully considered but deemed unpersuasive.

In response to Applicant's arguments against the Guo reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Although Guo does not disclose the nitrile rubber copolymer to have a Mooney viscosity of less than 10, it would be obvious to instead use the hydrogenated rubber copolymer taught in each of the three secondary references due to the enhanced processing properties of the resultant tape roll article as discussed in item 14 of FOA.

Applicant's assertions are incorrect as to the nitrile rubber polymers disclosed in the prior art of the instant rejection not possessing a Mooney viscosity of less than 10. Each of the three secondary references of the instant rejection (that is, Guerin'939, Ong **or** Guerin'320) teaches hydrogenated nitrile polymers having a Mooney viscosity of less than 10. (See, e.g., Experiment 3 in col. 9 of Guerin'939; Abstract of Ong; Examples 1 and 4 on Tables 2 and 3, respectively, and claim 3 of Guerin'320)

Thus, the claims, as amended, remain unpatentable over Guo in view of Guerin'939, Ong **or** Guerin'320.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571)272-8916. The examiner can normally be reached on Monday-Thursday 8:00-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RPG

/John J. Figueroa/  
Examiner, Art Unit 1796